

App. No. 10/008,413
Office Action Dated November 2, 2005

REMARKS

Favorable reconsideration is requested in view of the above amendments and the following remarks. Claim 26 is amended to include the limitation of claim 33, which is canceled without prejudice or disclaimer. Editorial revisions are made in claims 27, 28 and 30.

Therefore, no new issues have been raised through the amendments. Claims 26-32 are pending.

Claims 26-33 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as being obvious over Uramoto et al. (JP 61-183868). Applicants respectfully traverse this rejection.

The explanation of the present invention and the reference from the previous Amendment remain relevant. Applicants are not repeating them here for the sake of brevity, and will focus on the responsive comments provided in the rejection.

The Office Action contends that "'hardly-soluble' is a relative term, and therefore, at least relative to one another, cobalt hydroxide is less soluble than cobalt oxide." See page 4. Applicants respectfully contend that this statement demonstrates the clear error in the rejection, and in particular the failure to take into account the actual language of claim 26, which defines numerical limits on the solubilities for the hardly soluble cobalt compounds and easily soluble cobalt compounds. The claimed minimum solubility for the easily-soluble cobalt compounds is two orders of magnitude greater than the claimed maximum solubility for the hardly-soluble cobalt compounds. Both cobalt monoxide and cobalt hydroxide, the two cobalt materials mentioned in the reference, have solubilities in the easily-soluble range. These two materials previously were and continue to be identified in the claims as easily-soluble compounds. The present record provides no reasonable basis for any assumption that either of the compounds could qualify as hardly-soluble cobalt compounds as defined by claim 26. The reference in no way teaches the presence of any other material that could be considered a hardly-soluble cobalt compound. Therefore, the reference fails to teach or suggest all of the features as claimed in independent claim 26, and the rejection should be withdrawn.

Pages 3 and 4 of the Office Action contend that the distinctions for the present invention over the reference focus on treatment steps that are not relevant to product claims. Applicants respectfully submit that this reflects a miscomprehension of the present invention, the arguments

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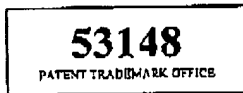
and the relevant law. The discussion of the treatment steps in fact demonstrates the erroneous interpretation of the reference by the rejection. More specifically, the discussion of the treatments shows that neither of the materials disclosed in the reference reasonably can be interpreted as meeting the required hardly-soluble cobalt compounds of claim 26. In other words, the absence of any such treatments in the reference shows that the materials disclosed in the reference in fact cannot be considered the hardly-soluble cobalt compounds of claim 26. That is, for example, cobalt hydroxide is not a hardly-soluble cobalt compound and becomes a hardly-soluble cobalt compound only when some action is taken, e.g. the treatment steps discussed in the present specification and listed in dependent claims. As the reference in no way suggests any treatment conditions that reasonably could be expected to convert the disclosed easily-soluble compounds into a hardly-soluble cobalt compound, the rejection fails to establish any basis for contending that the features of claim 26 are found inherently in the reference.

Similar reasoning applies to the x-ray diffraction charts. More specifically, the "Compound 1" of Fig. 1 is produced by Example 1 and corresponds to claim 27. The "Compound 2" of Fig. 1 is produced by Example 2 and corresponds to claim 28. The "Compound 3" of Fig. 2 is produced by Example 3 and corresponds to claim 30. See pages 9-11 of the specification for further details. The x-ray diffraction data show that the starting materials were converted into a different, i.e. hardly-soluble, form only when specific action was taken to make the conversion. Again, nothing in the reference suggests that any steps were taken that would have produced a hardly-soluble cobalt compound, and there is no reasonable basis from the present record for the rejection's assertion that hardly-soluble cobalt compounds are present in the reference.

The rejection also contends that the discussion of advantages achieved by the present invention can be disregarded due to the specific advantages not being mentioned in the claims. Applicants respectfully point out that it has been well-settled since the decision in In re Papesch over forty years ago that a material and its properties cannot be separated. Therefore there is no need for the claims to recite the advantageous properties that the invention inherently possesses. In any event, as discussed above, the reference fails to teach or suggest the limitations that are expressly claimed in claim 26. Therefore, the reference fails to establish prima facie obviousness, and it is not necessary to establish secondary considerations to support the patentability of the present invention.

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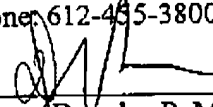
Favorable reconsideration in the form of a Notice of Allowance is respectfully requested.
Any questions regarding this communication can be directed to the undersigned attorney,
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Respectfully submitted,

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